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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,342	06/05/2001	Hiroto Yoshii	35.G2835	5188

5514 7590 06/07/2005

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EXAMINER

NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,342

Applicant(s)

YOSHII ET AL.

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 32-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 32-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment, filed on 02/22/2005, has been entered. Claims 11-31 are cancelled. Claims 1-10 and 32-52 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-5, 8-10, 32-33, 35-36, 39-43, 45-46 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, US Patent No. 6,757,826 and further in view of Hoover, US Patent No. 6,209,102.

4. As to claims 1, 32, 42 and 52, Paltenghe discloses a signature processing method for displaying a signature on a display unit, comprising:

an inputting step, of inputting a signature handwritten by a user via a digitizer, the signature being composed of at least one stroke (col. 3, lines 6-15: an individual's

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signature graphic may be obtained by capturing the pen strokes utilized by an individual to sign their name)

a control step, of displaying, the signature being inputted via the digitizer on the display unit in a manner that makes it possible for the user to discern the stroke of the signature, while the signature is inputted via the digitizer in said inputting step (col. 1, lines 38-49, col. 5, lines 52-59, and col. 6, line 62 – col. 7, line 6: an individual may visually recognize their own signature while having assurances that their signature was not forged)

However, Paltenghe does not explicitly disclose the signature being inputted via the digitizer on the display unit in a manner that makes it difficult for others to discern the stroke of the signature. Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user also has an option of hiding the PIN (signature) during the process of entering or selecting the PIN by clicking on the button "Hide PIN" in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Hoover and Paltenghe to include displaying PIN (signature) on the display device with the option of "Hide PIN" during the process of entering or selecting the PIN so it would protect the user's PIN (signature) from disclosure to an attacker who, directly or indirectly obtains the sequence of characters inputted by the user to gain access to a transaction.

5. As to claims 2, 33 and 43, Paltenghe and Hoover (Paltenghe-Hoover) disclose determining whether an instruction is given by the user to display the stroke of the signature in a manner and that makes it possible for the user to discern the stroke of the signature; wherein said control step is executed in response to a determination in said determining step that the instruction is given, and wherein said control step includes displaying, in a normal fashion, the stroke of the signature being inputted via the digitizer on the display unit when it is determined in said determining step that the instruction is not given (Paltenghe, col. 1, lines 38-49, col. 5, lines 52-59, and col. 6, line 62 – col. 7, line 6: an individual may visually recognize their own signature while having assurances that their signature was not forged), and it is difficult for the other to discern the stroke of the signature (Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user also has an option of hiding the PIN (signature) during the process of entering or selecting the PIN by clicking on the button “Hide PIN” in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Hoover and Paltenghe to include displaying PIN (signature) on the display device with the option of “Hide PIN” during the process of entering or selecting the PIN so it would protect the user’s PIN (signature) from disclosure to an

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attacker who, directly or indirectly obtains the sequence of characters inputted by the user to gain access to a transaction)

6. As to claims 4, 35 and 45 Paltenghe-Hoover disclose the control step includes displaying the stroke of the signature by using a combination of the color background and a color of the stroke of the signature, the combination being such as to make it difficult to discern the stroke of the signature (Paltenghe, col. 3, lines 33-52 and col. 6, lines 27-40 and col. 8, lines 14-29).

7. As to claims 5, 36 and 46, Paltenghe-Hoover disclose wherein, said control step includes displaying the stroke of the signature with an image pattern of the background in a manner that makes it difficult for others to discern the stroke of the signature and that makes it possible for the user to discern the stroke of the signature (Paltenghe, col. 12, lines 31-56).

8. As to claims 8, 39 and 49, Paltenghe-Hoover disclose wherein the portion of the stroke the signature is a portion of the stroke input within a predetermined period of time before the current input time (Paltenghe, col. 12, line 61 – col. 13, line 4).

9. As to claims 9, 40 and 50, Paltenghe-Hoover disclose wherein, said control step includes displaying the stroke of the signature in a flashing manner (Paltenghe, col. 6, lines 27-40 and col. 8, lines 14-29).

10. As to claims 10, 41 and 51, Paltenghe-Hoover disclose wherein the signature comprises coordinate data which is input using a coordinate input unit (Paltenghe, col. 3, lines 46-52 and col. 12, lines 31-56).

11. Claims 3, 34 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell et al. (McConnell), US Patent No. 6,148,093, Paltenghe, US Patent No. 6,757,826 and further in view of Hoover, US Patent No. 6,209,102.

12. As to claims 3, 34 and 44, McConnell discloses a signature processing method for displaying a signature on a display unit, comprising:

a registering step, of registering a signature handwritten by a user via a digitizer, the signature being composed of at least one stroke which is inputted by a user via a digitizer (Abstract, Figs. 2-3, 5a and 6, col. 7, lines 53-55 and col. 9, lines 31-39);

However, McConnell does not disclose a control step, of displaying the stroke of the signature registered in said registering step on the display unit in a manner that makes it possible for the user to discern the stroke of the signature. Paltenghe discloses in col. 3, lines 6-15: an individual's signature graphic may be obtained by capturing the pen strokes utilized by an individual to sign their name and col. 1, lines 38-49, col. 5, lines 52-59, and col. 6, line 62 – col. 7, line 6: an individual may visually recognize their own signature while having assurances that their signature was not forged. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to combine the teachings of Paltenghe and McConnel to include displaying the stroke of the signature on the display unit in a manner that makes it possible for the user to discern the stroke of the signature. Paltenghe's digital graphic signature system may be advantageously utilized in electronic transactions, including transactions over the Internet and network systems, and may also be advantageously utilized in conjunction with information banking and virtual wallets.

However, McConnel and Paltenghe do not explicitly disclose the signature being inputted via the digitizer on the display unit in a manner that makes it difficult for others to discern the stroke of the signature and a determining step whether an instructions is given by the user to display the stroke of the signature when the user fails to remember a registered signature. Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user also has an option of hiding the PIN (signature) or showing the PIN during the process of entering or selecting the PIN by clicking on the button "Hide PIN" in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Hoover and Paltenghe to include displaying PIN (signature) on the display device with the option of "Show PIN" so it would make the user to see his or her PIN or with the option of "Hide PIN" during the process of entering or selecting the PIN so it would protect the user's PIN (signature) from disclosure to an

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attacker who, directly or indirectly obtains the sequence of characters inputted by the user to gain access to a transaction.

13. Claims 6-7, 37-38 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, US Patent No. 6,757,826 and Hoover, US Patent No. 6,209,102 as discussed in claims 1-5, 7-15, 27-25 and 27-31 above, and further in view of Powell et al. (Powell), US Patent No. 5,650,943.

14. As to claims 6, 37 and 47, Paltenghe disclose a control step, of displaying, the signature being inputted via the digitizer on the display unit in a manner that makes it possible for the user to discern the stroke of the signature, while the signature is inputted via the digitizer in said inputting step (col. 1, lines 38-49, col. 5, lines 52-59, and col. 6, line 62 – col. 7, line 6: an individual may visually recognize their own signature while having assurances that their signature was not forged). However, Paltenghe does not explicitly disclose the signature being inputted via the digitizer on the display unit in a manner that makes it difficult for others to discern the stroke of the signature. Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user also has an option of hiding the PIN (signature) during the process of entering or selecting the PIN by clicking on the button “Hide PIN” in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10). It would have been obvious to one of ordinary skills in

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the art at the time the invention was made to combine the teachings of Hoover and Paltenghe to include displaying PIN (signature) on the display device with the option of "Hide PIN" during the process of entering or selecting the PIN so it would protect the user's PIN (signature) from disclosure to an attacker who, directly or indirectly obtains the sequence of characters inputted by the user to gain access to a transaction. However, Paltenghe and Hoover do not explicitly disclose wherein, said control step includes displaying the stroke of the signature as broken lines. Powell discloses in Fig. 24A and col. 18, line 49 - col. 19, 60 that a signature is displayed as a dotted line (broken line). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Powell and Paltenghe-Hoover to include the signature is displayed in broken line so it would be hard to detect the signature.

15. As to claims 7, 38 and 48, Paltenghe-Hoover-Powell disclose wherein, said control step includes displaying only a portion of the stroke of the signature in a manner that makes it difficult for others to discern the stroke of the signature and that make it possible for the user to discern the stroke of the signature (Paltenghe, col. 1, lines 38-49, col. 5, lines 52-59, and col. 6, line 62 – col. 7, line 6: an individual may visually recognize their own signature while having assurances that their signature was not forged; Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user

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also has an option of hiding the PIN (signature) during the process of entering or selecting the PIN by clicking on the button "Hide PIN" in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10) . Powell discloses in Fig. 24A and col. 18, line 49 - col. 19, 60 that a signature is displayed as a dotted line (broken line). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Powell and Paltenghe-Hoover to include the signature is displayed in broken line so it would be hard to detect the signature).

Response to Arguments

In the remarks, Applicant(s) argued in substance that

A) Prior art does not teach or suggest displaying the signature in a manner that makes it difficult for others than the user to discern the signature.

As to point A, Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user also has an option of hiding the PIN (signature) during the process of entering or selecting the PIN by clicking on the button "Hide PIN" in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10).

B) Prior art, taken separately or in any possible combination, the result would not have the feature cited in claim 1.

As to point A, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, an inputting step, of inputting a signature handwritten by a user via a digitizer, the signature being composed of at least one stroke (col. 3, lines 6-15: an individual's signature graphic may be obtained by capturing the pen strokes utilized by an individual to sign their name), a control step, of displaying, the signature being inputted via the digitizer on the display unit in a manner that makes it possible for the user to discern the stroke of the signature, while the signature is inputted via the digitizer in said inputting step (col. 1, lines 38-49, col. 5, lines 52-59, and col. 6, line 62 – col. 7, line 6: an individual may visually recognize their own signature while having assurances that their signature was not forged). However, Paltenghe does not explicitly disclose the signature being inputted via the digitizer on the display unit in a manner that makes it difficult for others to discern the stroke of the signature. Hoover discloses a method and apparatus for secure entry of access codes in a computer environment comprising a

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user inputting his access code such as PIN or Password (signature) into the computer environment to access a transaction, the user also has an option of hiding the PIN (signature) during the process of entering or selecting the PIN by clicking on the button "Hide PIN" in the computer environment (Abstract, Fig. 1 and col. 2, line 25 – col. 3, line 10). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Hoover and Paltenghe to include displaying PIN (signature) on the display device with the option of "Hide PIN" during the process of entering or selecting the PIN so it would protect the user's PIN (signature) from disclosure to an attacker who, directly or indirectly obtains the sequence of characters inputted by the user to gain access to a transaction.

16. Applicant's arguments filed 02/22/2005 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 3, 34, 44 have been considered but are moot in view of the new ground(s) of rejection. Please see the rejection and response to arguments above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER